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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Harald Lichtinger

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
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EXAMINER

MCCALL, ERIC SCOTT

ART UNIT

PAPER NUMBER

2855

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Please find below and/or attached an Office communication concerning this application or proceeding.



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EXAMINER

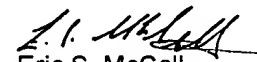
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Commissioner for Patents


Eric S. McCall
Primary Examiner
Art Unit: 2855

**METHOD AND APPARATUS FOR SENSING SEAT
OCCUPANT WEIGHT**

NOTICE OF NON-RESPONSIVE AMENDMENT

After consultation with the Special Programming Examiners of Tech Center 2800, the Applicant's provisional petition dated March 15, 2005 has been treated as a request for reconsideration.

As such, the amendment filed on March 15, 2005 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed claims raise new issues which require further consideration or search (37 CFR 1.116(c)). See also 37 CFR 1.198.

The request for reconsideration has not been found to be persuasive and thus the accompanying amendment has been found to be non-responsive. The purpose of this Notice of Non-Responsive Amendment, which follows a similar notice dated Feb. 17, 2005, is to point out the reasoning why the Examiner will not enter the said amendment.

As a background of the proceedings since the Board of Patent Appeals decision, claims 1-7, 19-21, and 24-38 were present in this application at the time of appeal of which the Board of Patent Appeals affirmed the rejection of claims 1-7, 24, and 31-37 under 35 USC 102(e) and reversed the rejection of claims 25-27 and 29 under 35 USC 102(e) and the rejection of claims 21, 30, and 38 under 35 USC 103(a).

In short the Examiner was affirmed on claims 1-7, 24, and 31-37. The Examiner was reversed on claims 21, 25-27, 29, 30, and 38.

Thereafter, the Examiner indicated (1/13/05) that claims 21, 25-27, 29, 30, and 38 were incomplete and further action by the Applicant was required as per MPEP 1214.06.

However, the Applicant failed to comply with MPEP 1214.06 by failing to cancel claims 1-7, 24, and 31-37 and putting claims 21, 25, 30, and 38 into independent format. MPEP 1214.06 states that if the Board or Court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, the Examiner, after expiration of the period for further appeal, should proceed in one of two ways:

- (1) Convert the dependent claim into independent form by Examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application;
or
- (2) Set a 1-month time limit in which the Appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will

not be permitted. If no timely reply is received, the Examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.

On Jan. 13, 2005, the Examiner chose the later of the two above methods. Thereafter, the Applicant's amendment dated Dec. 08, 2004 was matched with the application (for unknown reasons, the Applicant's amendment was not matched with the application until after the Examiner's Jan. 13, 2005 correspondence).

In response to the Examiner's correspondence, the Applicant then resubmitted their response (Jan. 28, 2005) which was then followed by a notice of a non-responsive amendment by the Examiner on Feb. 17, 2005.

The Applicant then submitted the above referenced provisional petition/request for reconsideration which led to this correspondence.

The reasoning behind this correspondence and thus the consecutive notices of non-responsive amendments can be traced back to the crossing of the Applicant's original amendment (12/08/04) after the Board's decision and the Examiner's notice of Jan. 13, 2005. Thus, this non-responsive amendment is to particularly point out why the amendment is non-responsive.

The Applicant's amendment is clearly not compliant with MPEP 1214.06.

First, the Applicant has amended claim 1 by including therein the subject matter of claim 21. However, the Applicant left claims 2-7 and 24-30 depend from claim 1. Thus, for the first time in the prosecution history claims 2-7 and 24-30 now depend from the subject matter that was originally claim 21. Never did claims 2-7 and 24-30 depend from claim 21. Claims 2-7 and 24-30, since they include the subject matter of original claim 21, were never previously considered. The Applicant is reminded that prosecution at this point and time is closed and to make such amendments at this time where claims are being considered for the first time would clearly raise new issues that would require further consideration and thus is improper.

As examples of such issues, the Examiner will not enter the said amendment because upon cursory review, there appears to be contradictions between the subject matter of the pending claims and the proposed amended claims.

First, a contradiction exists between claim 21 and the subject matter of claims 2-7 and 24-30 which was not an issue prior because claims 2-7 and 24-30 did not depend from claim 21. However, the Applicant is now attempting to add the subject matter of claim 21 to claim 1 while leaving claims 2-7 and 24-30 depend therefrom.

For example, claim 1 called out for at least one sensor. Claim 21 which directly depended from claim 1 called out for “said sensor” which was interpreted at the time of examination as the “at least one sensor” of claim 1 being defined as one and only one sensor in claim 21. However, some of the claims in the grouping of claims 2-7 and 24-30 call out for the “at least one sensor” to be more than just one sensor. Thus, a contradiction appears to be present.

Second, claim 24, which depended directly from claim 1 and not claim 21 called for the first and second track forming an inboard track assembly wherein the at least one sensor was mounted thereto. Therefore, the at least one sensor was interpreted as being actually mounted to either or both the first and/or second tracks. Now claim 24 is proposed as depending from what was claim 21, and the previous interpretation of the at least one sensor being mounted to either or both the first and/or second tracks is no longer consistent.

Claims 2-7, 24, and 30, if entered, would now, after the Boards’ decision and when prosecution is closed, be considered for the first time because of the addition of the subject matter of claim 21 to claim 1.

Third, the Applicant has amended claim 31 to include the subject matter of claim 38. However, the Applicant has not cancelled claims 34-37 which along with claim 31 were affirmed by the Board of Patent Appeals. Thus, claims 34-37 now depend from what was claim 38, and never did claims 34-37 depend from claim 38. Claims 34-37, if entered, would now, after the Boards’ decision and when prosecution is closed, be considered for the first time.

After cursory review, the Applicant has proposed amending claim 31 to include the subject matter of claims 32, 33, and 38. However, claims 34-37 never depended from claim 38 and after cursory review contradictions appear to be present between amended claim 31 and claims 34-37.

For example, claim 37 which never before depended from claim 38 calls for a first sensor assembly comprising a first track assembly and a second sensor assembly comprising a second track assembly.

However, the subject matter of appealed claim 38 which has now been incorporated into proposed claim 31 calls for the first sensor assembly being separate from the first track assembly and the second sensor assembly being separate from the second track assembly. Thus, a contradiction exists.

The Examiner points out that the above is not a complete list of discrepancies but just a few examples based upon a cursory review.

Clearly, such discrepancies do not “obviously” place the application into condition for allowance.

Response to Arguments

The Applicant has argued that (reversed) claim 21 has been incorporated into (affirmed) claim 1 and (reversed) claims 2-7 and 24 now depend from a claim (ie. claim 21) that the Board has indicated as being allowable. However, the Examiner points out that claims 2-7 and 24 never depended from claim 21 so their dependency now from amended claim 1 has never been previously considered and to substantially change the dependency of the claims at this point and time as proposed (and in view of the above issues) is not proper.

Likewise, the Applicant has argued that (reversed) claim 38 has been incorporated into (affirmed) claim 31 and (reversed) claims 34-37 now depend from a claim (ie. claim 38) that the Board has indicated as being allowable. However, the Examiner points out that claims 34-37 never depended from claim 38 so their dependency now from amended claim 31 has never been previously considered and to substantially change the dependency of the claims at this point and time as proposed (and in view of the above issues) is not proper.

Next, the Applicant has made comparisons between the current situation and amending claims prior to a Notice of Appeal (top of page 11). The Examiner simply states that no such comparison can be drawn because the two circumstances are vastly different. (1) prosecution is not closed prior to the Notice of Appeal; (2) vastly different rules apply between the two situations; (3) the Examiner is not the one that has found claims 21, 25-27, 29, 30, and 38 allowable over the prior art; and (4) such an amendment would not be entered after-final if, upon “cursory” review, the proposed amendment raised new issues that required further consideration.

Next, the Applicant has cited MPEP 1214.07 to support their arguments. However, the Examiner points out that the Applicant's amendments do not "obviously" place the application into condition for allowance upon cursory review as required by MPEP 1214.07 due to the above inconsistencies between the pending claims and the proposed amended claims.

If an amendment is to be entered under MPEP 1214.07, that amendment must put the application into "obvious" condition for allowance. Changing the dependency of claims after the decision by the Board of Patent Appeals has been handed down so that claims now depend from other claims for the first time in the prosecution does not place this application into obvious condition for allowance.

To point out the extent of the Applicant's amendment, the Applicant is proposing to have "each" of claims 2-7, 24, and 30 now depend from claim 21, and "each" of claims 34-37 now depend from claim 38. In short, of the 22 claims before the Board of Patent Appeals, the Applicant is now attempting to change the dependency of 12 claims.

Finally, the Applicant raises MPEP 1214.07 to support their arguments. However, MPEP 1214.07 is more of a generalization of an amendment that may be entered after the Board's decision. Nonetheless, such an amendment has to "obviously" place the application into condition for allowance and thus such an amendment would be deemed "minor". In view of the above, the Applicant's amendment is not minor and does not "obviously" place the application into condition for allowance.

The Examiner, on the other hand, has relied upon MPEP 1214.06 to support his position wherein MPEP 1214.06 addresses the exact situation currently at hand.

CONCLUSION


In closing, because none of the Applicant's amendments after the Board's decision were entered, the Applicant needs to:

- a) Cancel claims 1-7, 24, and 31-37;
- b) Amend claim 21 into independent format;
- c) Amend claim 25 into independent format (claims 26-29 will depend therefrom);
- d) Amend claim 30 into independent format; and
- e) Amend 38 into independent format.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric S. McCall whose telephone number is (571) 272-2183.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERIC S. McCALL
PRIMARY EXAMINER

MAY 26, 2005